

REMARKS

This application contains claims 1-43, the status of which is as follows:

(a) Claims 1-20, 24, and 35 were canceled by previous amendments. The Applicant may prosecute these claims in a continuation application.

(b) Claims 21-23, 25-34, and 36-40 were previously presented.

(c) Claims 41-43 are new.

No new matter has been added. Reconsideration is respectfully requested.

Paragraphs [0015] and [0072] of the specification (paragraph numbering from the published application) have been amended to add the phrase "in a sent items folder" in several places. The amended language is inherent in the Applicant's description of saving sent e-mails "as is the default setting of most e-mail programs" (paragraph [0015]). At the time the application was filed, standard e-mail programs saved sent e-mails by default in a sent items folder, as would have been known to any person of even minimal skill in the art. This phrase has been added to provide literal support for a feature of new claims 41-43, as described hereinbelow.

Claims 21-23, 25-28, 30-33, and 36-39 were rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,687,741 to Ramaley et al. The Applicant respectfully traverses this rejection. The Ramaley patent describes techniques for sending a file to a recipient from within a desktop application program being used by a sender:

A desktop application program provides a single entry point for indicating that a file is to be sent to a recipient. In response to an indication that the file is to be sent, a determination is automatically made as to whether the file should be sent as a link, as an attachment, or as both a link and an attachment. If the file has not been saved to a disk location or if the file has not been saved to a shared disk location, the file is sent as an attachment to an e-mail note. If the file has been saved to a shared disk location, the file is sent to the recipient as a link in an e-mail note. . . (abstract).

The file is sent as the link in the e-mail note by "launching [an] e-mail application program, instructing the e-mail application program to create the e-mail note, inserting the link to the shared disk location in the body of the e-mail note, and instructing the e-mail application program to send the e-mail note to the recipient" (col. 9, lines 27-33).

In contrast, independent claims 21, 22, and 23 of the present application recite techniques for sending an e-mail message together with an attachment to a recipient, and, in response to the sender's instructions, saving the e-mail message *without* the attachment on the computer of the sender. These techniques allow the sender to selectively conserve disk space by not saving unwanted attachments, while still saving the e-mail message for future reference. These techniques thus obviate the need for a sender wishing to conserve disk space to manually delete attachments from e-mails after the e-mails have been sent.

In the rejection, the Examiner referred to a step in the techniques of Ramaley in which the sender is given the option to *not* save a file (col. 7, lines 30-42). This option occurs when the sender has created a file within a desktop application program, but has not yet saved the file to disk. In this case, the sender is prompted to save the file before sending it to the recipient (col. 7, line 40). If the sender declines to save the file in response to the prompt, the file is perforce sent as an attachment, because the file cannot be sent as a link to a shared disk location (col. 7, lines 38-47). Although the file has not yet been saved by the *desktop application program*, Ramaley neither teaches nor suggests that the *e-mail application program* does not save the attached file together with the e-mail note on the sender's computer. Because such saving of attached files together with e-mail notes ordinarily occurs during conventional e-mail processing, in the absence of specific teaching to the contrary, there is no reason to assume such saving does not occur in the techniques of Ramaley.

The Examiner further argued that sending a file as a link is equivalent to "sending the e-mail message and the attachment" and "saving . . . the e-mail message without the attachment on a computer of the sender," as recited in claim 21 of the

present application. The Applicant respectfully submits that this comparison is incorrect for at least two reasons:

- Sending a file as a link is not equivalent to sending the file as an attachment. Ramaley clearly makes this distinction: "The system and method of the present invention comprise functionality for automatically determining whether a file should be sent as a link, as an attachment, or as both a link and an attachment" (col. 2, lines 37-40). As discussed above, in those cases in Ramaley in which the file is sent as an attachment, the attachment is saved on the computer of the sender. Thus Ramaley does not teach the combination of the third and fourth elements of claim 21, "sending the e-mail message and the attachment to the recipient; and saving . . . the e-mail message without the attachment."
- If we assume, for the sake of argument, that a link is equivalent to an actual attachment, just as the link (equivalent to the attachment) is sent with the e-mail message in Ramaley, the link (equivalent to the attachment) is saved with the sent e-mail note on the sender's computer. Ramaley thus still fails to teach the combination of the third and fourth elements of claim 21.

Furthermore, even if we assume, for the sake of argument, that sending a file as a link is equivalent to sending the file as an attachment without saving the attachment, Ramaley fails to teach the second element of claim 21, "receiving as input from the sender an instruction indicative of whether to save the attachment on a computer of the sender." According to the techniques of Ramaley, the sender is not offered the option whether to send the attachment as a link:

The present invention is designed to automatically determine the appropriate manner for sending a file, whenever possible. Therefore, there is no need to confuse the sender with options for sending a file as a link or as an attachment, or both (col. 5, lines 32-36).

The preferred embodiment of the present invention assumes that all shared files should be sent as links, which point to the shared disk

location. By sending a shared file as a link, the recipient is able to access the shared file even after it has been subsequently modified by the sender. Thus, sending a shared file as a link provides greater levels of data concurrency. A shared file may be sent as both a link and an attachment, however it will never be sent as only an attachment in the preferred embodiment (col. 5, line 62 – col. 6, line 3).

As mentioned, a shared document will, by default, be sent as a link (col. 6, lines 7-8).

The Applicant thus submits that claim 21 is not anticipated by Ramaley. The Examiner rejected parallel claims 22 and 23 on the same grounds as claim 21. The Applicant therefore submits that these claims are also allowable.

In view of the patentability of independent claims 21, 22, and 23, the Applicant respectfully submits that dependent claims 25-34 and 36-40 are also allowable, because they depend from independent claims 21, 22, or 23.

For the sake of argument, should the Examiner's rejection of claims 21, 22, and 23 be sustained, the Applicant now argues the independent patentability of a portion of the claims that depend therefrom.

Claims 27, 32, and 38 recite saving "information identifying the attachment" with the e-mail message. In rejecting these claims, the Examiner offered the mere assertion that Ramaley teaches this claim element, without any arguments. In the absence of arguments to the contrary, the Applicant submits that these dependent claims recite independently allowable subject matter.

Claims 28, 33, and 39 recite saving "a name of the attachment with the e-mail message" (on the computer of the sender without the attachment, as per claims 21, 22, and 23). The Examiner argued that this claim element is anticipated by col. 7, lines 55-64 of Ramaley. This portion of Ramaley describes techniques for determining whether the file to be sent is saved in a shared disk location by examining the address path of the disk location. Examples of address paths include "\\server\doc1.doc". Ramaley makes no suggestion that a file name such as

"doc1.doc" should be saved with the e-mail message on the computer of the sender without the attachment. The Applicant thus submits that these dependent claims recite independently allowable subject matter.

Claims 29, 34, and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ramaley in view of US Patent 6,327,612 to Watanabe. The Applicant respectfully traverses this rejection. At the time the present invention was made, the inventors were under obligation to assign the invention to International Business Machines Corporation (IBM), which was also the assignee of the application that issued as the Watanabe patent. Assignments to IBM of the present application and the application that issued as the Watanabe patent have been duly filed and recorded. The Watanabe patent issued after the February 14, 2001 filing date of the present application, and thus is available as potential prior art against the present application only under 35 U.S. 102(e). Therefore, pursuant to 35 U.S.C. 103(c), the Watanabe patent is not available under 35 U.S.C. 103(a) as potential prior art against the present application. Consequently, claims 29, 34, and 40 are believed to be independently patentable over the cited art.

Claims 41-43 are new, and find support in the specification as amended, as discussed hereinabove. In view of the patentability of independent claims 21, 22, and 23, the Applicant respectfully submits that new dependent claims 41-43 are also allowable. However, for the sake of argument, should the Examiner's rejection of claims 21, 22, and 23 be sustained, the Applicant submits that the teachings of Ramaley do not relate to saving or not saving an attachment in any sort of folder associated with an e-mail application program, let alone a sent items folder as recited in claims 41-43. In particular, the step in Ramaley cited by the Examiner regarding the sender's option to *not* save the file (col. 7, lines 30-42) relates to not saving the file from a *desktop application program* to a local or shared disk location. This step in Ramaley bears no relationship to not saving an attachment in a sent items folder of an e-mail application program, as recited in claims 41-43. Consequently, claims 41-43 are believed to be independently patentable over Ramaley.

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The Applicant believes the remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

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Respectfully submitted

A handwritten signature in black ink, appearing to read 'S. Peter Ludwig', written over a horizontal line.

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